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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,228	11/17/2003	Teresa Hickok	19783-025001 ./	5020
20985	7590	03/31/2006	24/1197US	
FISH & RICHARDSON, PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER WILSON, JOHN J	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/715,228		HICKOK ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	John J. Wilson		3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/20/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Banko (3930173). Banko shows an ultrasonic tip, shank 14, Fig. 1A, connector 14a enclosing a hollow internal volume 23, working end 22, void as shown in Fig. 1A, a hole at end of 21 that connects to a groove as shown, Fig. 1A and column 6, lines 10-14, and at least one bend, the bend from left to right in Fig. 1A is distal to the hole and groove interface. As to claim 4, see column 7, lines 60 to column 8, line 3.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Banko (3930173) in view of Bussiere (D261932). Banko does not show a void having a planar base. Bussiere shows a void having a planar base. It would be obvious to one of ordinary skill in the

art to modify Banko to include a void shaped as shown by Bussiere in order to make use of art known shapes of known structures.

Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Banko (3930173). Banko shows the structure as described above, to include a central axis that does not pass through the void is merely a matter of a choice in the degree of the depth of the void to one of ordinary skill in the art. As to claims 8 and 9, the specific shape of the groove is an obvious matter of choice in the shape of a known element to the skilled artisan. As to claim 10, the method of producing the groove is an obvious matter of choice in processing steps to one of ordinary skill in the art.

Claims 11, 13 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Banko (3930173) in view of Jacoby (5230621). Banko shows the structure as described above, however, does not show using a rasp or file. Jacoby teaches using a file for the working end, column 2, line 47. It would be obvious to one of ordinary skill in the art to modify Banko to include a file as shown by Jacoby in order to make use of the desired tool to complete the desired procedure. The specific type of file used is an obvious matter of choice in known files to the skilled artisan. As to claim 15, Jacoby teaches a file, using cross grooves on a file is well known and would have been obvious to one of ordinary skill in the art. As to claim 16, Banko does not show using a hollow tube. Jacoby shows an embodiment in Fig. 3b that teaches a tube 53, 55 having an opening 57. The tube passes through the tip as show. Jacoby also shows an embodiment, Figs. 7, 7b, where the element 24 is located in a groove, Fig. 7b. It would be

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obvious to one of ordinary skill in the art to modify Banko to include a tube as shown by Jacoby in order to deliver the desired accessory to the work site. As to claim 17, to use a bushing is an obvious matter of choice in known ways of mounting a tube to the skilled artisan. As to claim 18, the specific range of length that the tube extends is an obvious matter of choice in size and positioning of the known elements to one of ordinary skill in the art. As to claims 19 and 20, the shape of the shank is an obvious matter of choice in the shape of the tool to perform the desired procedure to the skilled artisan.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Banko (3930173) in view of Hahn (6139320). Banko does not show a ball at the working end. Hahn shows using a ball working end 154, Fig. 13. It would be obvious to one of ordinary skill in the art to modify Banko to include a ball working end as shown by Hahn in order to use the tool needed to perform the desired procedure.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Banko (3930173) in view of Kleesattel et al (3058218). Banko does not show a drill at the working end. Kleesattel shows using a drill, Fig. 7, at the working end. It would be obvious to one of ordinary skill in the art to modify Banko to include a drill working end as shown by Kleesattel in order to use the tool needed to perform the desired procedure.

***Drawings***

The drawings filed November 17, 2003 have been found to be acceptable by the examiner.

***Conclusion***

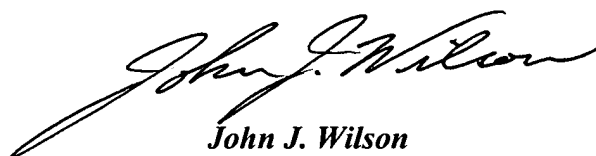
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Burt (3518766) and Dieras et al (6312256) show grooves. Blank (3375583) shows a tube 116. Hickok (6910889) shows cross grooves.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722). The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver, can be reached at 571-272-4720). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script, reading "John J. Wilson".

**John J. Wilson**  
**Primary Examiner**  
**Art Unit 3732**

jjw  
March 24, 2006